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Schlumberger Technology Corporation,
Schlumberger Reservoir Completions
14910 Airline Road
P.O. Box 1590
Rosharon, TX 77583-1590

EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,187

Applicant(s)

LEISMER, DWAYNE D.

Examiner

Zakiya N. Walker

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 21-30, drawn to a safety apparatus or shear sub having a control line shear mechanism, classified in class 166, subclass 376.
 - II. Claims 17-20, drawn to a control line cutting mechanism, classified in class 166, subclass 54.5.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed merely requires a control line shear mechanism, which can include any one known in the art. The subcombination has separate utility such as cutting a control line in any capacity or environment, or used in combination with many different apparatuses.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 3672

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Jeffrey E. Griffin on 7/17/02 a provisional election was made without traverse to prosecute the invention of group I, claims 1-16 and 21-30. Affirmation of this election must be made by applicant in replying to this Office action. Claim 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

7. The abstract of the disclosure is objected to because in line 1, the term "[t]he present invention discloses" is an implied term. Correction is required. See MPEP § 608.01(b). Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The disclosure is objected to because of the following informalities:

✓ Page 10, lines 1-2, the sentence beginning with "[s]ome embodiments" is incomplete.

Appropriate correction is required.

9. The following changes have been made by informal examiner's amendment:

Page 1, line 1 the term "priority from" has been replaced with --the benefit of U.S.-- in order to properly reference a provisional application.

Page 9, line 1 the term "passageway 38" has been replaced with -- passageway 36--.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-13 and 21-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Leismer et al.

Leismer et al. discloses an emergency downhole disconnect tool that includes first and second members 12, 14 (or shear sub 10), a control line shear mechanism having first and second shear members (shearing blades 90, 92), a control line 30, and a control line passageway (31, 12, 14). The reference further teaches that blades 90, 92

Art Unit: 3672

may be hydraulic or solenoid driven. The reference even further teaches a release mechanism 26 comprising a shear element 58, and the control line passageway comprising a recess 62 (on members 12 and 14). The method teaches separating first and second members 12, 14 (or safety joint/sub 10), and connecting two segments of tubular string (not shown connected at 20 and 22). The method further teaches providing the tubular string with safety sub, attaching a control line, inserting the string in the well, separating the string at the sub, cutting the control line, and the upper portions of the string and line may be removed from the well.

12. Claims 1-5, 8-12, 21-25, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wittrisch'635 (cited by applicant).

Wittrisch'635 discloses equipment for a pipe string that includes first and second members 8, 1, a control line shear mechanism 12 having first and second shear members (bottom of 8, 4), a control line 3, and a control line passageway (7, 5). The reference further teaches a release mechanism comprising a shear element 11, and the control line passageway comprising an external recess 7, 5. The method teaches separating first and second members 8, 1 (or safety joint/sub 10), and connecting two segments of tubular string 1a, 1b. The method further teaches providing the tubular string with safety sub, attaching a control line, and inserting the string in the well.

13. Claims 1-5, 8-16, 21-25, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wittrisch'312 (cited by applicant).

Wittrisch'312 discloses equipment for a pipe string that includes first and second members 5, 3 (or shear sub 1, 1e), a control line shear mechanism 16 having first and

Art Unit: 3672

second shear members (blades 18, 15), a control line 2, and a control line passageway (1d, 5, 3, 1e). The reference further teaches a release mechanism comprising a shear element 11, a pair of shearing blades 18, 15, and the control line passageway positioned at an angle (at 15 and 12) and comprising an external recess 9, 8 and enclosed passageway (bore of 1). The method teaches separating first and second members 5, 3 (or safety joint/sub 1, 1e), and connecting two segments of tubular string 1d, 1e. The method further teaches providing the tubular string with safety sub, attaching a control line, and inserting the string in the well.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Monday-Thursday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 746-3826 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Application/Control Number: 09/839,187

Art Unit: 3672

Page 7

A handwritten signature in black ink, appearing to read 'Zakiya N. Walker', with a long horizontal flourish extending to the right.

Zakiya N. Walker
Examiner
Art Unit 3672

ZW

July 18, 2002